

### **REMARKS / ARGUMENTS**

In view of the claim amendments above and the following remarks and arguments, Applicant believes the pending application is in condition for allowance.

#### **I. Status of the Claims**

Claims 2-4 and 7-13 are amended to correct grammatical errors, to achieve idiomatic consistency, and to correct for erroneous claim dependencies. No new matter is added by the amendments.

Claims 1 and 2 are further amended to recite the additional element of “having a shrinkage percentage at 120°C of equal to or less than 10%” and claim 4 is further amended to recite the additional element of “a film comprising said layers A and B having a shrinkage percentage at 120°C of equal to or less than 10% before the anchor coat is provided.” Support for these elements can be found in the Specification as originally filed, for example, on page 18, lines 8-10. No new matter is added by the amendments.

New claims 14 and 15, depending from claims 1 and 2, respectively, are added. Support for these new claims can be found in the Specification as originally filed, for example, on page 21, lines 5-7. No new matter is added by the new claims.

Claims 1-15 are pending.

#### **II. New Matter Objection under 35 U.S.C. § 132(a)**

The Amendment filed on January 18, 2006 is objected to under 35 U.S.C. § 132(a) because, according to the Examiner, it introduces new matter into the disclosure of the invention. Specifically, the material objected to as not being supported by the original disclosure is the phrase “having an average particle diameter of 1.4  $\mu\text{m}$ ” on page 31 of the Specification.

Applicant respectfully submits that the absence of this phrase from the Specification as originally filed was due to a mistake by the translator. The present application is a U.S. National

Phase Application under 35 U.S.C. § 371 of International Patent Application No. PCT/JP2004/010198, which was published in Japanese on January 27, 2005 as WO 2005/007403 A1 under PCT Article 21(2). Exhibit A accompanying this paper shows pages 22-23 of the WO publication, including paragraph [0096].<sup>1</sup> This paragraph corresponds to the paragraph that follows Table 1 on page 31 of the Specification. Exhibit B is a certified English translation of this paragraph.<sup>2</sup>

The certified English translation shows that the subject matter of “having an average particle diameter of 1.4  $\mu\text{m}$ ” was already disclosed in the original PCT application, from which the present U.S. application claims priority, and thus does not constitute new matter. Accordingly, Applicant respectfully requests that the new matter objection be withdrawn.

### **III. Claim Rejections under 35 U.S.C. § 112**

Claims 10-13 are rejected under 35 U.S.C. § 112 as indefinite. Specifically, claims 10 and 12 recite the element of “the inorganic deposited film,” which lacks an antecedent basis. Claims 11 and 13 depend from claims 10 and 12, respectively.

Claims 10 and 12 have been amended to depend from claims 3 and 9 instead of claims 1 and 2, respectively. Claims 3 and 9, as amended, recite the element of “an inorganic deposited film layer formed on one of the at least two layers.” This provides an antecedent basis for the element of “the inorganic deposited film layer” recited in claims 10 and 12 as amended.

Accordingly, Applicant respectfully requests that the rejections of claims 10-13 on grounds of indefiniteness be withdrawn.

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<sup>1</sup> The page numbers indicated in Exhibit A are 20 and 21 instead of 22 and 23. This is because the two cover pages of the WO publication are not counted in the indicated page numbers.

<sup>2</sup> A certificate of translation is attached as Exhibit C.

#### IV. Claim Rejections under 35 U.S.C. § 103(a)

Claims 1-3, 9, 10, and 12 are rejected under 35 U.S.C. § 103(a) as unpatentable over US 6,153,276 to Oya et al. (“Oya”) or JP 10-151715 (“JP ‘715”) in view of the Examiner’s statement of ordinary skill in the art. The Examiner states that Oya or JP ‘715 in combination with ordinary skill in the art renders the claims obvious.

Claims 1 and 2 have been amended to recite the element of “having a shrinkage percentage at 120°C of equal to or less than 10%.” Applicant respectfully submits that neither Oya nor JP ‘715 discloses this element, either explicitly, implicitly, or inherently.<sup>3</sup> Further, Applicant respectfully submits that no suggestion or motivation exists, either in Oya or JP ‘715 or in the knowledge generally available to one of ordinary skill in the art at the time of the present invention, to modify Oya or JP ‘715 to produce an aliphatic polyester film “having a shrinkage percentage at 120°C of equal to or less than 10%.”<sup>4</sup>

At least for these reasons, Oya or JP ‘715 in view of the Examiner’s statement of ordinary skill in the art does not render claim 1 or 2 as amended *prima facie* obvious. Accordingly, Applicant respectfully requests that the rejections of claims 1 and 2 on this basis be withdrawn.

Claims 3, 9, 10, and 12 depend directly or indirectly from claim 1 or 2. Therefore, at least for the same reasons as stated above, Oya or JP ‘715 in view of the Examiner’s statement of ordinary skill in the art does not render these claims *prima facie* obvious. Applicant respectfully requests that the rejections of claims 3, 9, 10, and 12 on this basis be withdrawn.

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<sup>3</sup> “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” MPEP, § 2143.03.

<sup>4</sup> “To establish a *prima facie* case of obviousness, . . . [f]irst, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” MPEP, § 2143. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *Id.*, § 2143.01, III (emphasis in original). “[The] fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness.” *Id.*, § 2143.01, IV (header).

**V. Claim Rejections under 35 U.S.C. § 103(a)**

Claims 4-8, 11, and 13 are rejected under 35 U.S.C. § 103(a) as unpatentable over Oya or JP '715 in view of the Examiner's statement of ordinary skill in the art and further in view of JP 2003-062933 ("JP '933"). The Examiner states that Oya or JP '715 in combination with ordinary skill in the art and JP '933 renders the claims obvious.

Claim 4 has been amended to recite the element of "a film comprising said layers A and B having a shrinkage percentage at 120°C of equal to or less than 10% before the anchor coat is provided." Applicant respectfully submits that neither Oya, JP '715, nor JP '933 discloses this element, either explicitly, implicitly, or inherently.<sup>5</sup> Further, Applicant respectfully submits that no suggestion or motivation exists, either in Oya, JP '715, or JP '933 or in the knowledge generally available to one of ordinary skill in the art at the time of the present invention, to modify Oya, JP '715, or JP '933 to use a method for forming an aliphatic polyester film in which "a film comprising said layers A and B [has] a shrinkage percentage at 120°C of equal to or less than 10% before the anchor coat is provided."<sup>6</sup>

At least for these reasons, Oya or JP '715 in view of the Examiner's statement of ordinary skill in the art and further in view of JP '933 does not render claim 4 as amended *prima facie* obvious. Accordingly, Applicant respectfully requests that the rejection of claim 4 on this basis be withdrawn.

Claims 5-8 depend directly or indirectly from claim 4. Therefore, at least for the same reasons as stated above, Oya or JP '715 in view of the Examiner's statement of ordinary skill in the art and further in view of JP '933 does not render these claims *prima facie* obvious. Applicant respectfully requests that the rejections of claims 5-8 on this basis be withdrawn.

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<sup>5</sup> See footnote 2 above.

<sup>6</sup> See footnote 3 above.

Claims 11 and 13 depend indirectly from claims 1 and 2, respectively. As discussed above, claims 1 and 2 have been amended to recite the element of “having a shrinkage percentage at 120°C of equal to or less than 10%.” Applicant respectfully submits that neither Oya, JP ‘715, nor JP ‘933 discloses this element, either explicitly, implicitly, or inherently.<sup>7</sup> Further, Applicant respectfully submits that no suggestion or motivation exists, either in Oya, JP ‘715, or JP ‘933 or in the knowledge generally available to one of ordinary skill in the art at the time of the present invention, to modify Oya, JP ‘715, or JP ‘933 to produce an aliphatic polyester film “having a shrinkage percentage at 120°C of equal to or less than 10%.”<sup>8</sup>

At least for these reasons, and since claims 11 and 13 depend, respectively, from claims 1 and 2, Oya or JP ‘715 in view of the Examiner’s statement of ordinary skill in the art and further in view of JP ‘933 does not render claim 11 or 13 *prima facie* obvious. Accordingly, Applicant respectfully requests that the rejections of claims 11 and 13 on this basis be withdrawn.

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<sup>7</sup> See footnote 2 above.

<sup>8</sup> See footnote 3 above.

